



Patent
Attorney Docket No. 032567-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Hiroshi Sumiyama et al.
Application No.: 09/238,163
Filing Date: January 28, 1999
Title: IMAGE FORMING APPARATUS

Group Art Unit: 2622
Examiner: JOSEPH R POKRZYWA
Confirmation No.: 6659

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

A Petition for Extension of Time is also enclosed.

Terminal Disclaimer(s) and the \$65.00 (2814) \$130.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

Also enclosed is/are _____

Small entity status is hereby claimed.

Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the \$395.00 (2801) \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).

Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.

Applicant(s) previously submitted _____

on _____, for which continued examination is requested.

Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

No additional claim fee is required.

An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims		MINUS =	0	x \$50.00 (1202) =	\$ 0.00
Independent Claims		MINUS =	0	x \$200.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$360.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

A check in the amount of _____ is enclosed for the fee due.

Charge _____ to Deposit Account No. 02-4800.

Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: 4-4-05

By William C. Rowland
William C. Rowland
Registration No. 30,888



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Attorney's Docket No. 032567-002

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RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner is thanked for the careful examination of the application.

However, in view of the following arguments, the Examiner is respectfully urged to reconsider and withdraw the outstanding rejections.

Claims 1, 4, 6, 9-13, and 16-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,113,520, hereinafter *Hirata* in view of U.S. Patent No. 5,448,376, hereinafter *Ohta*. Concerning the Examiner's description of the teachings of *Hirata*, Applicants' comments submitted on March 5, 2004 and on August 16, 2004 are incorporated herein by reference. In particular, Applicants continue to dispute the determination that the key buffer 41 of *Hirata* corresponds to the claims memory for storing image forming conditions.

Furthermore, Applicants note that the Examiner acknowledges that *Hirata* fails to expressly disclose causing the output unit to output image data newly input from the image input unit after the discarding of image data from the first memory under the maintained image forming conditions. To overcome this deficiency of *Hirata*, the

Examiner now relies on *Ohta*. However, the description of *Ohta* set forth in the Official Action is clearly erroneous. Specifically, the Official Action indicates that the parameter ROM 11 of *Ohta* corresponds to the memory of the present invention that stores the image forming conditions.

With regard to claim 1, e.g., the second memory stores image forming conditions under which the image output unit prints the image data that is stored in the first memory. Accordingly, the second memory is defined as storing image forming conditions for printing image data. As described on page 10 of the application, examples of the image forming conditions may include, for example, the number of copies or the magnification level of the copy.

On page 4 of the Official Action, it is stated that the parameter ROM 11 of *Ohta* corresponds to the memory for storing image forming conditions of claims 1, 10, 16, and 19. However, *Ohta* is quite different from the present invention. Specifically, the purpose of *Ohta* is to provide an image processing apparatus that automatically detects an undesired image in an image of a document and removes the undesired image from the stored image data before the image is processed. See column 1, lines 9-11 and 37-41. In the *Ohta* device, the ROM 11 is used for storing information, defined as "geometry parameters" to enable the system to detect the undesired images. Basically, the parameter ROM 11 holds information relating to the undesired images that are to be deleted from the image data. See column 4, lines 16-18 and lines 51-58. Based on this review of the reference, it is clear that *Ohta* does not store image forming conditions in the ROM 11. Instead, *Ohta* stores information concerning "candidate images" which are to be identified and deleted from image data. Accordingly, the basis for the rejection set forth in the outstanding

Official Action is based on an erroneous understanding of *Ohta*, and the basis for combining *Hirata* with *Ohta* is no longer valid.

In view of the fact that *Ohta* does not teach or suggest a system that includes image forming conditions in parameter ROM 11, the rejection is based on an incorrect understanding of the reference and must be withdrawn.

Claims 7, 8, 14 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Hirata* in view of *Ohta*, and further in view of U.S. Patent No. 5,152,001, hereinafter *Hanamoto*. However, *Hanamoto* does not overcome the deficiency based on the combination of *Hirata* and *Ohta* set forth above. Accordingly, the rejection of claims 7, 8, 14 and 15 must also be withdrawn.

In view of the foregoing remarks, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection. If there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: 4-4-05

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